

REMARKS

The Applicant gratefully acknowledges the Examiner making the Deutch, et al. reference, U.S. Patent No. 5,577,115 of record.

The Applicant gratefully acknowledges the Examiner's withdrawal of the rejection of the pending claims under 35 USC §102 and 35 USC §103.

Claims 1-17 are rejected under 35 USC § 112, second paragraph as failing to set forth the subject matter which the Applicant regards as their invention. The Examiner asserts that there is evidence that the claims fail to correspond in scope with that which Applicant regards as the invention and further asserts that such evidence can be found in the reply filed on September 30, 2005. Specifically, the Examiner points to the second page of the Remarks in that reply and asserts that the Applicant has stated that the invention of claim 1, along with those of other claims, have a modem that is essentially connected in series with a premise output for receiving only the voice service from the modem. The Examiner then concludes that the statement indicates that the invention is different from what is defined in the claims because (1) the claim does not recite such a modem, and (2) more importantly, such a modem was used by Applicant to distinguish the claimed invention from the '115 reference.

The undersigned Attorney for the Applicant has carefully reviewed the Remarks of the September 30, 2005 Response and respectfully asserts that the Examiner has misinterpreted or misconstrued those remarks as will now be discussed. The Examiner pointed to the second page of the Remarks in his rejection. On the second page of the Remarks, in distinguishing from the '115 reference, the following remarks were included:

"While the '115 reference shows directing B-channel data services along one path and B-channels voice services along another path, it does not teach nor suggest a module which allows both services to pass through a modem and be filtered in the modem such that only the voice services exit from the modem to the premise output. For these reasons, Applicant contends that

claim 1, is distinguishable from the '115 reference and that the '115 reference does not teach nor suggest the combination of elements as recited in claim 1.”

Additionally, in referring to the ‘115 reference on the same page of the Remarks the following is quoted:

“It does not teach nor suggest a communications module which passes both voice and data services to a modem and receives only voice services from the modem essentially connected in series with a premise output for receiving only the voice service from the modem. The present invention dispenses with the need for the parallel lines out '115 running to the speaker or handset therefore providing a patently distinct improvement over '115.”

Turning now to the claims, Claim 1 requires, inter alia, a modem output for passing the voice and data services to a modem, a modem input for receiving only the voice service from the modem, and a premise output for receiving only the voice service from the modem input. Likewise, claim 6 requires, inter alia, a modem output for passing selected ones of the communication lines to a modem and a modem input for receiving the selected ones of the communication lines from a modem. Both of these claims are directed to a communications module for use in a premise wiring system. Although the module has inputs and outputs to and from a modem, the modem is not part of the invention and therefore not required by the claims. Reference to the modem in the claims is merely to apply a descriptive name to the inputs and outputs and also to recite function of those inputs and outputs. For example, the element referred to as a “modem output” indicates that that output is connectable to a modem to achieve the function of passing voice and data services to the modem as is clearly recited in claim. Furthermore, the Remarks support Applicant's assertion that the modem is not part of the Applicant's invention. In referring to the '115 reference, as quoted above, the Applicant explained that, “it does not teach nor suggest a module which allows both services to pass through a modem and be filtered in the modem such that only the voice services exit from the modem to the premise output.” Is clear from that statement that the Applicant is referring to the fact that the claimed invention, namely a communications module, has the ability to, or the function of, allowing both services to pass through a modem. The modem is not required to be

part of the claimed communications module. The remarks with regard to claim 6, are similar and therefore Applicant's contentions with regard to those remarks are the same in that, they merely recite function of the modem input a modem output without requiring a modem to be part of the claimed communication module. For brevity, these arguments will not be repeated here. Applicant therefore contends that the Examiner cannot show any evidence in the September 30, 2005 response that claims 1, 6 and those that depend therefrom fail to correspond in scope with that which the Applicant regards as the invention.

With respect to independent claim 12, the remarks of the September 30, 2005 response, specifically those remarks appearing in the first full paragraph on page 8, do not refer to nor suggest the requirement of a modem. Therefore, Applicant respectfully contends that because there is no reference made to a modem being required in those remarks regarding claim 12 and additionally because of the reasons stated above, the Examiner has not shown any evidence that this claim and those that depend therefrom fail to correspond in scope with what Applicant regards as the invention.

With respect to independent claim 17, that claim is to a process of distributing voice and data signals. The Remarks of September 30, 2005 and specifically the remarks referring to claim 17 indicate that the Applicant contends that the '115 reference does not teach nor suggest filtering in the modem and sending back only the voice signals to the module. That remark is clearly consistent with the recitation of claim 17. There is therefore, nothing in the Remarks which goes beyond the scope of claim 17. The Applicant respectfully contends that the Examiner has not presented any evidence that this claim fails to correspond in scope with that which Applicant regards as the invention. Additionally, the Examiner's comment that the claim does not recite a modem does not appear to be relevant to this claim as this claim is directed to a process.

In view of the remarks presented here, reconsideration and withdrawal of the rejection of claims 1-17 under 35 USC § 112, second paragraph is requested.

For all of the foregoing reasons and in view of the foregoing remarks, Applicants respectfully contend that the application is in condition for allowance. Reconsideration and passage to issue therefore requested. Please charge any additional requisite fees relating to this amendment and response to Deposit Account No. 501581.

Respectfully submitted,

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